REMARKS

[0002]   Applicant respectfully requests entry of the following remarks and reconsideration of the subject application. Applicant respectfully requests entry of the amendments herein. The remarks and amendments should be entered under 37 C.F.R. §1.116 as they place the application in better form for appeal, or for resolution on the merits.

[0003]   Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 1-11, 13-14, 17-18, 20, 31-32, 35-37 and 42-49 are presently pending. Claims 1, 11, 13-14, 17-18, 20, 31-32, 36-37, 42-44, 48 and 49 have been amended herein. Claims 12, 19, 21-28, 30, 33-34, 38 and 50 have been cancelled herein. No new claims have been added herein.

Statement of Substance of Interview

[0004]   Examiner Duffield and his supervisor, Examiner Beliveau, graciously talked with me—the undersigned representative for the Applicant—on July 15th, 2008 over the telephone.   Applicant greatly appreciates the Examiners' willingness to talk. Such willingness is invaluable to each of us in our common goal of an expedited prosecution of this patent application.

[0005]   During the interview, I discussed how the claims differed from the cited references, namely Tomsen.   Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments.

[0006] The Examiner was receptive to the proposals, and I understood the Examiner to indicate that the proposed clarifying claim amendments appeared to distinguish over the cited references. However, the Examiner indicated that he would need to review the cited references more carefully and do another search, and requested that the proposed amendments be presented in writing.

[0007] Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited references of record for at least the reasons discussed during the interview.

Formal Request for an Interview

[0008] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can discuss this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0009] Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

Claim Amendments

[0010] Without conceding the propriety of the rejections herein and in the the interest of expediting prosecution, Applicant amends claims 1, 11, 13-14, 17-

18, 20, 31-32, 36-37, 42-44, 48 and 49 herein. Applicant amends claims to clarify claimed features. Such amendments are made to expedite prosecution and to more quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claimed invention in response to the cited references.

[0011] The amendments to claims 1, 11, 13-14, 17-18, 20, 31-32, 36-37, 42-44, 48 and 49 are fully supported by the Application and therefore do not constitute new matter. Please see at least Figures 4a and 4b and their corresponding discussions in the specification.

Serial No.: 10/602,500
Atty Docket No.: MS1-1372US
Atty/Agent: Jacob P. Rohwer
-23-
lee&hayes   The Business of IP™
www.leehayes.com   509.324.9256

Substantive Matters

Claim Rejections under §112 2nd ¶

[0012]   Claim 22 is rejected under 35 U.S.C. §112, 2nd ¶. In light of the cancelation of claim 22, Applicant submits that this rejection is moot. Accordingly, Applicant asks the Examiner to withdraw this rejection.

Claim Rejections under § 102 and § 103

[0013]   Claims 1-14, 17-28, 30-38 and 42-50 are rejected under 35 U.S.C. §102 and §103. In light of the amendments presented herein and the discussion during the above-mentioned Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0014]   The Examiner's rejections are based upon the following references alone and in combination:

- **Tomsen:** *Tomsen, et al.,* US Publication Patent No. 2002/0147984 (published October 10, 2002);
- **Corey:** *Corey, et al.,* US Patent No. 5,703,655 (issued December 30, 1997);
- **Harris:** *Harris, et al.,* US Patent No. 7,114,170 (issued September 26, 2006);
- **Taylor:** *Taylor, et al.,* US Patent No. 6,710,812 (issued March 23, 2004); and

Serial No.: 10/602,500
Atty Docket No.: MS1-1372US
Atty/Agent: Jacob P. Rohwer
-24-
lee&hayes   The Business of IP™
www.leehayes.com   509 324 9256

- **Kay:** *Kay, et al.,* US Patent No. 7,110,714 (issued September 19, 2006).

Overview of the Application

[0015]   The Application describes broadcasting interactive content without using triggers embedded in the broadcast content. When a viewer sees an item of interest while viewing a program, the viewer can initiate a request for information (RFI) about that item with a single button actuation. When the RFI is entered, a client device, such as a set-top box, detects the RFI and transmits RFI data to a server, including the channel viewed, a time stamp and a system-defined amount of closed captioning data. The RFI data is cross-referenced with program time code information, programming guide information, program information and/or advertiser information to determine the context of the RFI, i.e. what the user saw that made the user enter the RFI. Information about the item is then sent to the viewer as a system message, an e-mail message, a post, or by way of any other delivery mode.

Cited References

[0016] The Examiner cites Tomsen as the primary reference in the anticipation- and obviousness-based rejections. The Examiner alternately cites Corey, Harris, Taylor and Kay as secondary references in the obviousness-based rejections.

Tomsen

[0017] Tomsen describes an interactive television system that initiates unprompted, context-sensitive requests for supplemental content related to a television broadcast or discrete segments thereof. The related supplemental content is received by the interactive television system and pre-cached in a storage device associated therewith. In response to a user command, the stored supplemental content is retrieved and displayed by the interactive television system.

Corey

[0018] Corey describes retrieving segments of stored video programs using closed caption text data. The closed caption text data is extracted from video programming signals received by the system. Text records based on the extracted closed caption text data are generated. Each text record is derived from the closed caption data for a single continuous video segment to which the text record serves as an index or key in retrieving this video segment.

Harris

[0019]   Harris describes presenting interactive and non-interactive media content to a client computer over a computer network.

Taylor

[0020]   Taylor describes a news search database containing a plurality of decoded closed caption common news story texts from geographically diverse television stations, which texts have format consistency regardless of the origin of the respective texts.

Kay

[0021]   Kay describes an interactive television commerce system for obtaining product information and for purchasing products through a two-way interactive broadcast distribution system, such as a cable or satellite television system.

Anticipation Rejections

[0022]   Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.[1] Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.[2]

Based upon Tomsen

[0023]   The Examiner rejects claims 1-3, 5-14, 17, 19-21, 31, 32, 35-38, 42-45 and 48-50 under 35 U.S.C. §102(e) as being anticipated by Tomsen. Applicant respectfully traverses this rejection. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

Independent Claim 1

[0024]   Applicant submits that Tomsen does not anticipate this claim because it does not show or disclose at least the following elements as recited in this claim, as amended (with emphasis added):

> "in response to determining the content item is a program, associating a rule defined in *a program rules module* with the

---

[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

[2] See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

program, wherein the **_program rules module organizes a plurality of programs broadcast by the network server into a table_**, the table comprising:

> **_a program identifier column_** identifying the program for which the client user entered a request for information;

> **_an action column_** providing information on what type of content related to the identified program is provided to the client user; and

> **_a delivery mode column_** specifying a mode of delivery of the content related to the identified program to the client user; and

in response to determining the content item is an advertisement, associating a rule defined in **_an advertiser rules module_** with the advertisement, wherein the **_advertiser rules module organizes a plurality of advertisers whom sponsor advertisements broadcast by the network server into a table_**, the table comprising:

> **_an advertiser identifier column_** identifying an advertiser sponsoring the advertisement for which the client user entered a request for information;

> **_an action column_** providing information on what type of content related to the identified advertiser is to be provided to the client user; and

> **_a delivery mode column_** specifying a mode of delivery of the content related to the identified advertiser to the client user."
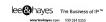
[0025] The Examiner indicates (Action, p. 4-6) the following with regard to this claim:

> Regarding claim 1, Tomsen teaches a method comprising:
>
> detecting a request for information (RFI) initiated by a user while accessing a content program (Para. 17, lines 1-9);
>
> transmitting RFI data to a server on a broadcast network (Para. 17, lines 1-2); and wherein the RFI data includes:
>
> a time at which the RFI was initiated; a channel accessed at the time the RFI was initiated (Para. 16, lines 1-9); and

closed caption data associated with the content program that occurred prior to and including the time at which the RFI was initiated (Para. 16, lines 1-9).

determining if the content program is a program or an advertisement (Para. 88, lines 1-11); Tomsen meets this limitation in the fact that an advertisement/program has to be identified for the purpose of accessing commercial opportunities (Para. 112, lines 4-8) and for receiving information on television programs (Para. 17, lines 7-9), wherein the determining comprises:

cross-referencing, at the server, a time at which the RFI was initiated, i.e. time which indicates when a user presses the "Find" button (Para. 80, lines 1-6), with content item time code data, i.e. indexed according to time at the content source (Para. 81, lines 1-9), to determine whether a program or an advertisement was scheduled at the time the RFI was initiated (Para. 81, lines 1-9; Para. 88, lines 1-11), wherein the time code information includes intra-program information relating to when commercials are scheduled within the program, i.e. supplemental content, which includes advertisements, are indexed according to time and stored at the content source (Para. 46, lines 5-11; Para. 81, lines 1-9);

in response to no such time code data being available, using the closed caption data to derive search terms, Note: The deriving of the keywords from the closed-captioning text does not depend on time code data. Therefore, Tomson meets this limitation (Para. 84, lines 1-12);

searching, at the server, a reference database using the search terms, i.e. searching the supplemental content at the content source (Para. 84, lines 1-12; Para. 87, lines 3-11); and

determining from matches derived from the search if the content item is a program or an advertisement (Fig. 1, el. 124; Para. 88, lines 3-10). Tomsen meets this limitation in the fact that an advertisement/program has to be identified for the purpose of accessing commercial opportunities (Para. 112, lines 4-8) and for receiving information on television programs (Para. 17, lines 7-9).

[0026]   Tomsen describes providing supplemental content related to a television broadcast. The system in Tomsen allows a user to send an unprompted, context-sensitive request for supplemental content related to the television program (or segment thereof) being viewed. (Tomsen Para [0070])

[0027]   The request contains contextual information so that a content source may determine the television program being viewed. The contextual information includes a channel identifier, a time index and closed caption data. (Tomsen Para [0077-0084])

[0028]   However, Tomsen is directed toward filtering supplemental content, so that the filtered supplemental content limits the amount of data pre-cached on a client set-top-box. For example, if the user regularly presses the "FIND" button during advertisements to access commercial opportunities, the supplemental content for such commercial opportunities is pre--cached. (Tomsen Para [0111-0112])

[0029] Thus Tomsen is directed toward filtering supplemental content so that supplemental content the user is most likely interested in is pre-cached at the set-top-box and delivered to the client via a system message.

[0030] Tomsen does not describe the program rules module or the advertiser rules module as recited in claim 1. These modules allow for programs and advertisers to be organized separately, into tables so that varying actions and delivery modes can be implemented for each particular program and/or advertiser in response to a request for information initiated by a viewer.

[0031] Tomsen appears to oppose this type of implementation because Tomsen filters supplemental content so that supplemental content most likely to be requested is pre-cached on the set-top-box so that the information can be displayed to a viewer. This limits the type of information delivered in association with the request for supplemental content and the delivery mode of the information provided in response to the request for supplemental content.

[0032] Consequently, Tomsen does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Independent Claims 31 and 42

[0033] Similarly, independent claims 31 and 42 each include at least one one feature similar to the claimed features as explained above with respect to claim 1. Thus independent claims 31 and 42 are allowable over the cited

Serial No.: 10/602,500
Atty Docket No.: MS1-1372US
Atty/Agent: Jacob P. Rohwer
-33-
lee&hayes   The Business of IP™
www.leehayes.com   509.324.9256

reference for at least similar reasons as claim 1. Accordingly, Applicant asks the Examiner to withdraw the rejections of these claims.

Dependent Claims 2-3, 5-11, 13-14, 17, 20, 32, 35-38, 43-45 and 48-49

[0034]   These claims ultimately depend upon one of independent claims 1, 31 or 42. As discussed above, claims 1, 31 and 42 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0035]   Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a prima facie case have not been met.

Based upon Tomsen

[0036]   The Examiner rejects claim 4 under 35 U.S.C. §103(a) as being unpatentable over Tomsen.   Applicant respectfully traverses the rejection of this claim. More specifically, the official notice taken by the Examiner in the rejection of this claim does not account for the deficiencies as explained above with respect to claim 1, from which claim 4 ultimately depends. Thus, Applicant asks the Examiner to withdraw the rejection of this claim.

Based upon Tomsen and Corey

[0037]   The Examiner rejects claims 18, 33 and 34 under 35 U.S.C. § 103(a) 103(a) as being unpatentable over Tomsen in view of Corey.   Applicant notes that claims 33 and 34 have been canceled. Furthermore, Applicant respectfully traverses the rejection of claim 18 at least because Corey does not account for the deficiencies in Tomsen as explained above with respect to claim 1, from

which claim 18 depends. Thus, Applicant asks the Examiner to withdraw the rejection of this claim.

Based upon Tomsen and Harris

[0038]   The Examiner rejects claims 22-28 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Tomsen in view of Harris.   Applicant notes that claims 22-28 and 30 have been canceled.   Additionally, Applicant notes that Harris does not account for the deficiencies in Tomsen as explained above with respect to claim 1.

Based upon Tomsen and Taylor

[0039]   The Examiner rejects claim 46 under 35 U.S.C. § 103(a) as being unpatentable over Tomsen in view of Taylor.   Applicant respectfully traverses the rejection of this claim at least because Taylor does not account for the deficiencies in Tomsen as explained above with respect to claim 42, from which claim 46 depends. Thus, Applicant asks the Examiner to withdraw the rejection of this claim.

Based upon Tomsen and Kay

[0040]   The Examiner rejects claim 47 under 35 U.S.C. § 103(a) as being being unpatentable over Tomsen in view of Kay.   Applicant respectfully traverses the rejection of this claim at least because Kay does not account for the deficiencies in Tomsen as explained above with respect to claim 42, from which

claim 47 depends. Thus, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claims

[0041]   In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

Conclusion

[0042]   All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application.   If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action**. Please call or email me at your convenience.

Respectfully Submitted,

Lee & Hayes, PLLC
Representatives for Applicant

  /Jacob Rohwer 61,229/   Dated: 7/22/2008
Jacob P. Rohwer (jacob@leehayes.com; 509-868-8323)
Registration No. 61,229
Bea Koempel-Thomas (bea@leehayes.com; x259)
Registration No. 58,213
Customer No. **22801**

Telephone: (509) 324-9256
Facsimile: (509) 323-8979
www.leehayes.com